UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trad mark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/884,186	06/15/97	BRUCHMANN B	524-2769-0

IM11/0202

OBLON SPIVAK MCCLELLAND
MAIER & NEUSTADT
CRYSTAL SQUARE FIVE FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON VA 22202

EXAMINER	
SERGENT, R	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 02/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/894,156	Bruchmann et al.
Examiner	**Group Art Unit**
Sergent	1711

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P riod for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on October 2, 1998.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachm nt(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Oth r _____

Office Acti n Summary

15.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

16.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohring et al (`350 or `936) in view of Wagner et al (`127 or `622) and Hennig et al (`956).

Mohring et al disclose the production of biuret containing polyisocyanates having a low unreacted polyisocyanate monomer content and light color, wherein diisocyanates are reacted with an alcohol component, including tertiary alcohols; an amine component; and water. See column 3, lines 10+ and columns 4-7.

17.

While Mohring et al disclose the use of amines, patentees fail to disclose the use of applicants' claimed amine containing stabilizer. However, applicants' claimed stabilizers were known at the time of invention to be useful agents for the production of biurets. See column 6, lines 8+; column 9, lines 9+; and column11, lines 55+, within Wagner et al. See column 1, lines 53+ and column 2 within Hennig et al. Furthermore, Hennig et al disclose that their biurets, derived from urea derivatives, are light in color. See examples.

18.

Therefore, one of ordinary skill in the art would have been motivated to utilize the amine containing biuretizing agents of the secondary references in place of the amine component of Mohring et al, because one would have reasonably expected the amine compounds of the primary and secondary references to function as equivalents. It has been held that it is prima facie obvious to substitute an equivalent component for another, where equivalency is known within the art. In re Ruff, 118 USPQ 343 (CCPA 1958). Furthermore, it has been held that it is prima facie obvious to combine components, known to be useful for the same purpose. In re Kerkhoven, 205 USPQ 1069. Therefore, the position is further taken that it would have been obvious to combine known biuretizing agents, such as tert-butanol and urea or formamide, for example, as disclosed by Wagner et al, to yield a biuretizing composition suitable for producing a biuret.

19.

Applicants have argued that their invention differs from the prior art, because applicants utilize their stabilizer in a catalytic amount. The examiner has considered this argument; however,

it is insufficient to remove the rejection, because applicants' catalytic amount of stabilizer is comparable to the amounts of nitrogen containing agents used within the art. Applicants disclose that a catalytic amount of stabilizer equates to 0.01 to 2.0 mole percent of stabilizer based on isocyanate groups in (a); the examiner assumes that this means that for every mole of isocyanate group, 0.0001 to 0.02 mole of stabilizer is used. This, in turn, equates to a molar ratio of diisocyanate to stabilizer of 5000:1 to 25:1. Mohring et al's examples disclose a molar ratio of diisocyanate to nitrogen containing compound of 24:1. Wagner et al disclose a molar ratio of at least 11:1, preferably 12:1 to 40:1. The position is taken that it is immaterial with respect to what names (i.e., biuretizing agents, stabilizers, or catalysts) are used to describe the components. The fact remains that equivalent compounds are being used in comparable amounts, within the processes.

20.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent:jp

January 20, 1999

RABON SERGENT
PRIMARY EXAMINER